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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,911	10/22/2003	Koichi Maari		6383
530	7590	01/22/2009	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			OBEID, MAMON A	
		ART UNIT	PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/690,911	MAARI, KOICHI	
	Examiner	Art Unit	
	MAMON OBEID	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 October 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 38-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 38-52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Acknowledgments

1. This communication is in reply to claims amendments filed October 10, 2008.
2. Claims 38- 52 are currently pending and have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 43-47 are rejected under 35 U.S.C. §101 because the claims are considered hybrid claims. See MPEP §2173.05(p) II. If Applicants overcome the related 35 U.S.C. §112 2nd paragraph rejection below, this particular 35 U.S.C. §101 rejection will be withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 38- 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 38, for example, recites, “receiving, from the player through the user terminal, an encoded message indicating that the player has received the content key and the use condition”. The Examiner submits that no support exists in Applicants original specification for an encoded message indicative of both: reception of the “content key” and the “use condition”. If Applicants disagree, Applicants need to provide proper evidence showing the relative support in support thereof. Upon receiving sufficient evidence, this rejection will be withdrawn.

Claim Rejections - 35 U.S.C. §112

8. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 48-52 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

10. Claims 43- 47 are indefinite because the claims are considered hybrid claims.

See MPEP §2173.05(p) II. In particular, the claims are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C §101.

11. For example, claim 48 begins "[a]n apparatus for administering distribution of content...." Additionally, claims dependent on claim 48 all begin "[t]he apparatus according to claim 43...". In light of this evidence, the Examiner interprets these recitations as express intent by Applicants to claim a *product* claim.

12. Claim 43 however continues with "an administration center" followed by a series of eight (8) method steps. In light of Applicants' recitation of no less than ten (10) method steps (e.g. "receiving from a user terminal", transmitting the content specifying information, "obtaining the specified content, "encrypting the specified content"...etc.), the Examiner interprets these particular recitations of method steps as express intent by Applicants to claim a *process* claim.

13. In light of the conflicting evidence noted above, claim 43 could reasonably be drawn to either a product or process. In accordance with §2173.05(p) II. which states that a single claim must be drawn to either a product or process (but not both) and because a competitor of Applicants would not know whether *possession* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited ten (10) method steps, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claims 43-47 as claims directed to a product only.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 38- 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ginter et al, US Patent No. 5,892, 900 (“Ginter”), in view of Stefik et al, US Patent No. 5,629,980, (“Stefik”) in view of Petrie, Jr et al (U.S. Patent No. 5,509,071)(“Petrie”).

16. **As per claim 38:** Ginter discloses the following limitations:

a. receiving, from a user terminal, a request that includes content specifying information which specifies the content desired by a user (figures 77-84; column 313,lines 38-56) and encrypting the content with a content key (figures 17-20; column 223, lines 5-13; column 312, lines 37-43; column 313, lines 38-56).

- b. generating use conditions associated with a content ID and a user ID (figures 19 and 26A, item 940; column 134, lines 29-38; column 155, lines 38-51; column 158, lines 58-65; column/line 159/12-160/33; column 215, lines 42-56; column 299 lines 45-49; column 311 lines 12-34; column 312 lines 37-43).
- c. transmitting the encrypted content having the content ID added thereto to a content server (column/line 307/4-308/43; column 309 lines 58-60; column 314 lines 1024; column/line 315/26- 316/5).
- d. transmitting the encrypted content stored in the content server, the content key and use condition through a user terminal to a player in response to a request from a user (figures 2, 2A and figures 79- 84; column 62 lines 31-50 and 52-64; column 137 lines 35-50).
- e. receiving a request for the content key from the player through the user terminal, the request including the content ID, and in response thereto, transmitting the content key and the use condition through the user terminal to the player (column 141, line 35- column 142, line 26; column 168, line 2- column 169, line 67).

17. Ginter does not explicitly disclose transmitting the encrypted content, the content key and the usage condition to a player through the user terminal, however, Stefik clearly discloses a rendering repository 203 (see at least figure 2 and column 3, line 50-column 4, line 35) which receives the encrypted digital work, an encryption key and a

set of rights associated with the digital work (see at least column 37 line, 37- column 38, line 50).

18. Therefore, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ginter's teachings to include the step of transmitting encrypted digital work, encryption key and the associated usage rights to a rendering system/ player disclosed by Stefik to maintain the security and integrity of the system by storing the digital work within a repository and attaching permanently to the digital work the associated usage rights and fees, See in Stefik (column 6, line 19- column 7, line 5).

19. Ginter further discloses an important function of an auditor (receiver of audit information) which is to pass administrative events back to a user VDE node in acknowledgement that audit information has been received and/or "recognized." The receipt and/or acceptance of audit information may be followed by two processes. The first event will cause the audit data at a VDE node which prepared an audit report to be deleted, or compressed into, or added to, one or more summary values. The second event, or set of events, will "inform" the relevant security (for example, termination and/or other consequence) control information (for example, budgets) at said VDE node of the audit receipt, modify expiration dates, provide key updates, and/or etc (column 296, lines 39- 56). Stefik further discloses the use of acknowledgements messages (column 33, lines 13- 59).

20. The combination Ginter/ Stefik failed to expressly disclose receiving, from the player through the user terminal, an encoded message indicating that the player has received the content key and the use condition, and decoding the encoded message to confirm that the player has received the content key and the use condition. However, Petrie discloses a process initiated by the recipient's requesting an artifact from the sender, who encrypts the requested artifact and an acknowledgment. Next, the sender encrypts the encrypted artifact and encrypted acknowledgment together and transmits the encrypted message to the recipient. The recipient decrypts the message to recover the encrypted artifact, as well as the encrypted acknowledgment which is returned to the sender. The sender decrypts the acknowledgment to verify receipt by the recipient of the encrypted artifact (column 3, lines 1- 29).

21. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the combination Ginter/ Stefik's teachings to incorporate acknowledgment messages, as disclosed by Petrie, teachings to provide a convenient and reliable system for providing to a sender proof of receipt by an intended recipient of an artifact conveyed as an encrypted electronic message thereby preventing/ reducing fraud (Petrie" column 2, lines 26- 54) .

22. **As per claim 39:** Ginter discloses generating the content key (column 214, line 3- column 216, line 4).

23. **As per claim 40:** Ginter discloses compressing the specified content (column 68 lines 43-59).

24. **As per claim 41:** Ginter discloses encrypting the content key prior to transmitting the content key (figure 19; column 135 lines 51- 59; column 137 lines 35-50 and 57-64).

25. **As per claim 42:** Ginter discloses executing a process to share a session key with the user and encrypting the use condition using the session key (figure 19; column 155 line 37- column 156, line 14; column 207 lines 20- 33; column 222 lines 40- 50).

26. **As per claims 43- 52:** the claims recite an apparatus for performing the method of claims 38- 42 and hence, they are rejected under the same reasoning as used in the rejections of claims 38- 42 shown above.

27. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art

and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

28. Applicant's arguments with respect to claim38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAMON OBEID whose telephone number is (571)270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.
32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
January 22, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621